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3-29-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

William J. BAER et al.

Application No.: 09/219,934

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Group Art Unit: 2155

Confirmation No.: 4144

Examiner: O. Duong

Filed: December 23, 1998

Technology Center 2100

FOR: METHOD AND APPARATUS FOR USING CLASSES, ENCAPSULATING DATA WITH ITS BEHAVIORS, FOR TRANSFERRING BETWEEN DATABASES AND CLIENT APPLICATIONS AND FOR ENABLING APPLICATIONS TO ADAPT TO SPECIFIC CONSTRAINTS OF THE DATA

**APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §1.193**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In accordance with 37 C.F.R. § 1.193(b)(1), Appellants submit the following remarks in response to the Examiner's Answer dated February 22, 2002.

Preliminarily, Appellants note that the Examiner's arguments on the merits appear to be a *verbatim* repeat of points made in the last Office Action. Appellants believe that their Brief frames Appellant's response completely, and so no further response *per se* is required here.

However, the Examiner has indicated the following change to Issues, part VI of the Appeal Brief: "The 'read-write capability features' are not cited in claims 1, 6, 12 and 18." Appellants respectfully disagree.

As presented previously, Appellants assert that the read-write capability features are inherent in the independent claims of the present application, and that the prior art fails to disclose or suggest such features, for all of the reasons set forth in the Appeal Brief.

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Accordingly, Appellants submit that the first issue identified in part VI of the Appeal Brief and argued in part VIII of the Appeal Brief is framed properly.

The Examiner also advises changes to Grouping of Claims, part VII of the Appeal Brief, stating that the rejection of claims 1, 6, 2 (should be 12) and 18; 2, 7, 3 (should be 13) and 19; 3, 9, 15 and 21; 4, 10, 16 and 22; 5, 11, 17 and 23; and 8, 14 and 20 stand or fall together because Appellants' brief allegedly does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. Appellants respectfully disagree.

Each of the foregoing groups of claims is called out specifically, and each group is argued separately in the Appeal Brief. It appears that the Examiner is not interpreting 37 C.F.R. § 1.192(c)(7) correctly. 37 C.F.R. § 1.192 (c) (7) provides that for each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together..." Appellants have provided six groups of claims, identified separately with respect to six issues, and have argued those six issues separately in the Appeal Brief. Thus, on the record presented to the Board, the Board can identify a representative claim from each of the six groups, and can decide the appeal as to each group based on a single claim from each group.

Viewed another way, when for example the Board decides that claim 1 is unpatentable, and hence that the other claims grouped with claim 1 are unpatentable, the Board cannot use that determination by itself to say that claim 2 and the other claims grouped with claim 2 are unpatentable. Rather, the Board will have to rule separately on claim 2 and the other claims grouped with claim 2. In similar fashion, as to each succeeding group, the Board's adverse

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decision on a preceding group will not determine whether the claims of the succeeding group(s) are patentable.

Pursuant to the foregoing, Appellants submit that the six groups of claims are properly identified separately, such that the claims within each such group stand or fall together, but each of the six groups must be treated separately.

Pursuant to the foregoing, Appellants respectfully request that the Board reverse the Examiner's rejection, and pass the application to allowance at the earliest opportunity.

Respectfully submitted,



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Date: March 14, 2002

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Date: March 14, 2002

Signed:   
Elaine E. Calimquim